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10/573,288	03/23/2006	Jordi Tormo i Blasco	4266-0148PUS1	9407

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EXAMINER

QAZI, SABIHA NAIM

ART UNIT	PAPER NUMBER
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1616

NOTIFICATION DATE	DELIVERY MODE
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11/16/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/573,288

Applicant(s)

BLASCO ET AL.

Examiner

Sabiha Qazi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

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Non-Final Office Action

Claims 1-20 are pending. No claim is allowed at this time.

Summary of this Office Action dated Monday, November 12, 2007

1. Request for Continued Examination Under 37 CFR 1.114
2. Information Disclosure Statement
3. Copending Applications
4. Specification
5. 35 USC § 102(b) Rejection
6. 35 USC § 103(a) Rejection
7. Communication

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Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/17/2007 has been entered.

Information Disclosure Statement

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Copending Applications

Applicants must bring to the attention of the examiner, or other Office official involved with the examination of a particular application, information within their knowledge as to other copending United States applications, which are "material to patentability" of the application in question. MPEP 2001.06(b). See *Dayco Products Inc. v. Total Containment Inc.*, 66 USPQ2d 1801 (CA FC 2003).

Specification

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

35 USC § 102(b) Rejection

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by COTTER et al, EP 988,790. See abstract and claims. The reference discloses synergistic fungicidal combination of azolopyrimidines and quinoxifen, which has been presently claimed.

See example 15 where fungicidal mixture of azolopyrimidine and quinoxifen against *Puccinia recondite* on wheat is disclosed. The mixture shows synergistic results. The data disclosed in Table XV on page 16 are the observed and expected efficacy with different rates.

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See example 16 where fungicidal mixture of azolopyrimidine and quinoxifen against *Blumeria graminis* on wheat is disclosed. The mixture shows synergistic results. The data disclosed in Table XVI on page 17 are the observed and expected efficacy with different rates.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-20 rejected under 35 U.S.C. 103(a) as being unpatentable over COTTER et al., EP 988,790. The reference teaches synergistic fungicidal mixtures of triazolpyrimidine and quinoxifen which embraces Applicant's claimed invention. See the entire document especially abstract, examples 15 and 16, and claims.

Instant claims differ from the reference in one specific combination.

It had been decided by Courts that the indiscriminate selection of "some" from among "many" is considered prima facie obvious. In re Lemin, 141 USPQ 814 (1964); National Distillers and Chem. Corp. V. Brenner, 156 USPQ 163.

The instant claimed compounds would have been obvious because one skilled in the art would have been motivated to prepare a synergistically effective fungicidal mixture of triazolpyrimidine and quinoxifen embraced by the genus of the above cited reference with the

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expectation of obtaining additional beneficial fungicidal mixture. The instant claimed invention would have been suggested to one skilled in the art.

Because of each compound appears to be well known in the prior art, it would appear that the combination of the compounds would have been obvious in view of MPEP 2144.06 and see Ex parte Quadranti, 25 USPQ2d 1071 (Bd. Pat. App. & Inter. 1992).

COTTER et al, EP 988,790 discloses synergistic fungicidal combination of azolopyrimidines and quinoxifen, which has been presently claimed.

See example 15 where fungicidal mixture of azolopyrimidine and quinoxifen against Puccinia recondite on wheat is disclosed. The mixture shows synergistic results. The data disclosed in Table XV on page 16 are the observed and expected efficacy with different rates.

See example 16 where fungicidal mixture of azolopyrimidine and quinoxifen against Blumeria graminis on wheat is disclosed. The mixture shows synergistic results. The data disclosed in Table XVI on page 17 are the observed and expected efficacy with different rates.

Synergistic data presented in the specification on page 11, examples 6 and 7 shows the difference in efficacy in observed and calculated 24 and 22 at a concentration of 1:4 and 4:1. The arguments are not found persuasive because first the results are not considered synergistic and unexpected because the reference teaches such combination. Second even if it is synergistic as applicant argue the concentration when synergism was observed is 1:4 and 4:1. The claimed invention does not contain such a limitation. The claimed invention would have been obvious because these compounds are known as has been also disclosed by the Applicants in the disclosure and the reference teaches such combination.

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See Ex parte Quadranti where it was held that

“Use of materials in combination, each of which is known to function for intended purpose, is generally held to be prima facie obvious, and in instant case, use of combination of herbicides is so notoriously well known as to be capable of being taken by official notice; generalizations such as Colby formula are not particularly useful in determining whether synergism has been demonstrated, since formula inherently results in expectation of less than additive effect for combination of herbicides, since there is no evidence that such approach is considered valid by significant number of ordinarily skilled workers in relevant area of technology, and since it could be reasonably argued that in most cases, additive or better than additive results could be expected for combination of herbicides.”

“There is no single, appropriate test for determining whether synergism has been demonstrated for chemical combination; rather, facts shown in each case must be analyzed to determine whether chosen method has clearly and convincingly demonstrated existence of synergism or unobvious result”.

“Assuming arguendo that the differences in values presented are statistically significant, there is no evidence that they represent a true, practical advantage. In re Freeman, 474 F.2d 1318, 177 USPQ 139 (CCPA 1973); In re Klosak , 455 F.2d 1077, 173 USPQ 14 (CCPA 1972); In re D'Ancicco, 439 F.2d 1244, 169 USPQ 303 (CCPA 1971). Also, prescinding from the Colby formula test, which as we have already indicated is at best controversial and in our view probably invalid, there is no evidence that the differences are unexpected. In re Merck, 800 F.2d 1091, 231 USPQ 375 (Fed.Cir. 1986); In re Longi , 759 F.2d 887, 225 USPQ 645 (Fed.Cir. 1985); In re Freeman, supra” .

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One having ordinary skill in the art would have been motivated to select the claimed compounds from the genus in the reference since such mixtures would have been suggested by the reference as a whole. It has been held that a prior art disclosed genus of useful synergistic mixtures is sufficient to render prima facie obvious a species falling within the genus. In re Susi, 440 F.2d 442, 445, 169 USPQ 423, 425 (CCPA 1971), followed by the Federal Circuit in Merck & Co. V. Biocraft Laboratories, 874 F.2d 804, 10 USPQ 2d 1843, 1846 (Fed. Cir. 1989).

In the light of the forgoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the instant claims would have obvious to one skilled in the art.

Response to Remarks

COTTER et al, EP 988,790 discloses synergistic fungicidal combination of azolopyrimidines and quinoxifen, which has been presently claimed.

See example 15 where fungicidal mixture of azolopyrimidine and quinoxifen against Puccinia recondite on wheat is disclosed. The mixture shows synergistic results. The data disclosed in Table XV on page 16 are the observed and expected efficacy with different rates.

See example 16 where fungicidal mixture of azolopyrimidine and quinoxifen against Blumeria graminis on wheat is disclosed. The mixture shows synergistic results. The data disclosed in Table XVI on page 17 are the observed and expected efficacy with different rates.

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as applicant argue the concentration when synergism was observed is 1:4 and 4:1. The claimed invention does not contain such a limitation. The claimed invention would have been obvious because these compounds are known as has been also disclosed by the Applicants in the disclosure and the reference teaches such combination.

Communication

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabiha Qazi, Ph.D. whose telephone number is 571-272-0622. The examiner can normally be reached on any business day. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter, Ph.D. can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



SABIHA QAZI, PH.D.
PRIMARY EXAMINER